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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,303	10/19/2000	Ann Kerstin B.K. Lindell	AC02736US	5740

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Joan M McGillicuddy
Akzo Nobel Inc
Intellectual Property Department
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,303

Applicant(s)

LINDELL ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 6-9, 11-14, 16 and 17 is/are rejected.
7) ☒ Claim(s) 10 and 15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: definitions of "coat" and "protect".

DETAILED ACTION

1. Receipt is acknowledged of applicant's response filed 23 August 2005. To clarify the record at this point in the prosecution, claims 1-17 are pending with claims 1-5 withdrawn from consideration.

Response to Arguments

2. Applicant's arguments filed 23 August 2005 have been fully considered but they are not persuasive.

Applicant argues:

The claimed invention relates to a process for coating a substrate to provide a non-tacky protective coating or film thereon. In contrast, Karim discloses adhesive compositions, i.e. compositions that are used to bind two substrates to each other (emphasis in original).

and

Karim does not mention or suggest that its adhesive composition would be suitable for use in a process for coating a substrate to provide a cured non-tacky protective coating or film thereon. It is submitted that the skilled artisan would not use an adhesive composition as a coating composition, because adhesives are used to bond two substrates, not to provide a (protective) coating layer on a substrate.

Although the phrase "to provide a non-tacky protective coating or film" appears only in the preamble of each independent claim, it is the examiner's position that this phrase serves to limit the structure of the claimed invention and must, consequently, be given patentable weight. The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application to gain an understanding of what the inventors actually invented and intended to encompass by the claim.¹ The examiner notes that the specification nowhere literally states that a "protective coating or film" is applied. Rather, as a review of pages 14 and 15 of the specification reveals, the "protective" nature of the film results

¹ *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990)

from the particular physical properties of the cured film, such as abrasion resistance. Therefore, it is the examiner's position that the "protective" nature of the coating or film, within the context of this invention, is an inherent physical characteristic of the coating/film and that any coating/film, applied according to the active process steps recited in the body of each independent claim, is inherently a "protective coating or film" within the context of the invention. Consequently, because Karim teaches and suggests coating and curing an adhesive composition according to all of applicant's recited process steps, the film inherently functions a "protective coating or film" within the context of the invention.

Further, the words of a claim must be given their plain meaning unless applicant has provided a clear definition in the specification.² Ordinary, simple English words, whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.³ As noted above, applicant has not provided any explicit definition of the phrase "protective coating or film" in the specification. The dictionary definition of the term "coat" is inclusive of providing a substrate with a protective layer.⁴ Further, the term "protect" means "to cover or shield from exposure, injury, or destruction."⁵ Consequently, any coating/film of any material on any surface necessarily serves to protect the underlying substrate, as evidenced both by the plain meaning of coating a substrate, and by the simple fact that any coating provides a physical barrier between the underlying substrate and overlying sources of exposure, injury, or destruction.

² *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

³ *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)

⁴ See attached.

⁵ *Ibid.*

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Simply put, the adhesive composition of Karim is coated on the substrate (11:31-47). Thus, it is a coating, regardless of its composition or ultimate end-use. Since Karim teaches and suggests all of applicant's process steps, the coated adhesive inherently possesses protective characteristics within the context of the invention. Consequently, applicant's argument is not persuasive.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 6-9, 11-14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karim et al. (US 6,057,382 A).**

These claims are rejected for the same reasons set-forth under this heading in the prior Office action.

Allowable Subject Matter

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6. Claims 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: These claims recite allowable subject matter for the reasons set-forth under this heading in the prior Office action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 9/1/2005
William Phillip Fletcher III
Patent Examiner, USPTO
Art Unit 1762


TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER

Webster's Seventh New Collegiate Dictionary

A Merriam-Webster
REG. U.S. PAT. OFF.

BASED ON
WEBSTER'S
THIRD
NEW INTERNATIONAL
DICTIONARY



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coaxial.ca













coach 1a











cing petroleum hydrocarbons and

scopic viscous liquid preservative
— used as an antifreeze and

by [L]: proportionately according
— **pro rata** *adv*

via *vi*: to divide, distribute, or
make a pro rata distribution

as *act* or *an* instance of prorating;
tion of crude oil or gas to some
active capacity of each producer

vi: **PROLOGUE**
— **prologue**, *p(r)ro- / -n*: the act of
prologued

prologuen, *fr. MF prologuer*, *fr. L*
vi to ask — more at **PRO-**, **RIGHT** *vi*
minate a session of (as a British
— **vi**: to suspend or end a legisla-

pro face to face with, towards, in
— **near**, towards, against, in re-
— **near**: toward (**prosenchy-**
— **ma**)

prosalutis, *fr. L prosa prose*
stinguished from poetry: **FACTUAL**
belonging to the everyday world

ly *adv*: — **prosaic** manner, style, or
— **prosaic** manner, style, or
— **prosaic** manner, style, or

prosaic 1: a prose writer 2: a
— **prosaic** manner, style, or

fr. It prosatore, *fr. ML prosator*, *fr.*
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— **prosaic** manner, style, or

specialized for conduction and support — **pros-en-chem-a-tous**
— **pros-en-chem-a-tous**

prose poem *n*: a work in prose that has some of the qualities of a
poem (as rhythm, patterned structure, or imaginative heightening)
— **prose** poet *n*

prose *er* *\prō-zə-* *n*: a writer of prose 2: one who talks or
writes tediously

Proser-pi-na *\prō-sər-pō-nə-* or **Proser-pi-ne** *\prō-sər-pī-nə-* *n*
[L *Proserpina*] *PERSEPHONE*

prose-ly *\prō-zə-lē-* *adv*: in a prosy manner

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pros-ti-tu-tion *\prōs-tə-(t)yū-shən-* *n*: the act or practice of
indulging in promiscuous sexual relations esp. for money 2: the
state of being prostituted: **DEBASEMENT**

prosto-mi-al *\prō-stō-mē-əl-* *adj*: of or relating to the pro-
stomium

prosto-mi-um *\prō-stō-mē-əm-* *n*, *pl* **prosto-mia** *\-mē-ə-* [NL,
fr. Gk pros- *stomach* *stomach*] the portion of the
head of various worms and mollusks situated in front of the mouth
and usu. held to be nonmetameric

prostrate *\prōs-trā-* *adj* [ME *prostrat*, *fr. L prostratus*, pp. of
prostrare, *fr. pro-* before + *sternere* to spread out, throw down
— more at **STREW**] 1 a: stretched out with face on the ground in
adoration or submission b: extended in a horizontal position
FLAT 2: lacking in vitality or will: **OVERCOME** 3: trailing on the
ground: **PROCUMBENT** (~ shrub) **SYN** see **PRONE**

prostrate *vi* 1: to throw or put into a prostrate position 2: to
reduce to submission, helplessness, or exhaustion: **OVERCOME**

prostration *\prō-strā-shən-* *n* 1 a: the act of assuming a prostrate
position b: the state of being in a prostrate position: **ABASE-**
MENT 2 a: complete physical or mental exhaustion: **COLLAPSE**
b: **HELPLESSNESS**, **POWERLESSNESS**

prosy *\prō-zē-* *adj* 1: **PROSAIC** 2: **TEDIOUS**

pro- or **proto-** *comb form* [ME *protho-*, *fr. MF, fr. LL proto-*, *fr. Gk*
prōt-, *prōt-*, *prōt-*; akin to *Gk pro-* before — more at **PRO-**]
1: first in time (protolithic) (*protonymph*) 2 a: first or lowest of
a series and as such usu. having the smallest relative amount of a
(specified) element or radical (*protoxide*) b: parent substance of
a (specified) substance (*protactinium*) 3: first formed: primary
(*protaxylem*) 4 *cap*: relating to or constituting the recorded or
assumed language that is ancestral to a language or to a group of
related languages or dialects (*Proto-Indo-European*)

prot-ac-tin-i-um *\prōt-ak-tīn-ē-əm-* *n* [NL]: a shiny metallic
radioelement of relatively short life — see **ELEMENT** table

prot-ag-o-nist *\prō-tag-ō-nist-* *n* [Gk *protāgonistēs*, *fr. prōt-* *prot-*
+ *agonistēs* competitor at games, actor, *agonizesthai* to compete,
fr. agōn contest, competition at games — more at **AGONY**] 1: one
who takes the leading part in a drama, novel, or story 2: the
leader of a cause: **CHAMPION** 3: a muscle that by its contraction
actually causes a particular movement

protamine *\prōt-ā-mēn-* *n* [ISV]: any of various simple strongly
basic proteins that are not coagulable by heat but are soluble in
water and dilute ammonia

prota-sis *\prōt-ās-* *n*, *pl* **prota-ses** *\-sēz-* [LL, *fr. Gk*
prota-, *fr. prot-*, *fr. prot-*; akin to *Gk pro-* before — more at **PRO-**]
1: first in time (protolithic) (*protonymph*) 2 a: first or lowest of
a series and as such usu. having the smallest relative amount of a
(specified) element or radical (*protoxide*) b: parent substance of
a (specified) substance (*protactinium*) 3: first formed: primary
(*protaxylem*) 4 *cap*: relating to or constituting the recorded or
assumed language that is ancestral to a language or to a group of
related languages or dialects (*Proto-Indo-European*)

prote- or **proteo-** *comb form* [ISV, *fr. F protéine*]: protein (*pro-*
teolysis) (*protease*)

protea *\prōt-ē-* *n* [NL, genus name, *fr. L Proteus*, sea god able
to assume various shapes]: any of a genus (*Protea*) of the family
Proteaceae, the protea family) of evergreen shrubs often grown for
their showy bracts and dense flower heads

protean *\prōt-ē-*, *prōt-ē-* *adj* 1: of or resembling Proteus
2: **VARIABLE** 2: readily assuming different shapes or roles

protease *\prōt-ē-ās-*, *-āz-* *n* [ISV]: **PROTEINASE**, **PEPTIDASE**

protect *\prōt-ēkt-* *vi* [L *protectus*, pp. of *protegere*, *fr. pro-* *in*
front + *tegere* to cover — more at **PRO-**, **THATCH**] 1 a: to cover or
shield from injury or destruction: **GUARD** 2: to save from con-
tingent financial loss 2: to shield or foster by a protective tariff
SYN see **DEFEND**

protection *\prōt-ēk-shən-* *n* 1: the act of protecting: the state
of being protected 2 a: one that protects b: the oversight or
support of one that is smaller and weaker 3: the freeing of the
producers of a country from foreign competition in their home
market by high duties or other restrictions on foreign competitive
goods 4 a: immunity from prosecution purchased by criminals
through bribery b: money extorted by racketeers posing as a
protective association 5: **COVERAGE** 2a — **protec-tive** *\-tēk-tiv-*
adj — **protec-tive-ly** *adv*

protec-tion-ism *\shə-nīz-əm-* *n*: the doctrine or policy of pro-
tectionists

protec-tion-ist *\sh(ə)-nəst-* *n*: an advocate of government eco-
nomic protection for domestic producers through restrictions on
foreign competitors — **protectionist** *adj*

protective tariff *n*: a tariff intended primarily to protect domestic
producers rather than to yield revenue

protec-tor *\prōt-ēkt-ər-* *n* 1 a: one that protects: **GUARDIAN**
b: a device used to prevent injury: **GUARD** 2: one having the care
of a kingdom during the king's minority: **REGENT** — **protec-tor-**
ship *\-shīp-* *n* — **protec-tress** *\-tēk-trəs-* *n*

protec-tor-al *\-tēk-t(ə)-rəl-* *adj*: of or relating to a protector or
protectorate

protec-tor-ate *\-tēk-t(ə)-rət-* *n* 1 a: government by a protector
b: the government of England (1653–59) under the Cromwells
c: the rank, office, or period of rule of a protector 2 a: the
relationship of superior authority assumed by one power or state
over a dependent one b: the dependent political unit in such a
relationship

protec-to-ry *\-t(ə)-rē-* *n*: an institution for the protection and
care usu. of homeless or delinquent children

pro-tégé *\prōt-ə-zhā-*, *prōt-ə-* *n* [F, *fr. pp. of protéger* to pro-
tect, *fr. L protegere*]: a man under the care and protection of an
influential person usu. for the furthering of his career

pro-tégée *\prōt-ə-zhā-*, *prōt-ə-* *n* [F, fem. of *protégé*]: a female
protégé

pro-teid *\prō-tēd-*, *prōt-ēd-* *n* [ISV, *fr. protein*]: **PROTEIN** 1

pro-teide *\prōt-ēd-* *n* [ISV, *fr. protein*]: **PROTEIN** 1

pro-tein *\prō-tēn-*, *prōt-ēn-* *n*, *often attrib* [F *protéine*, *fr. LGk*
prōteios primary, *fr. Gk prōtios* first — more at **PROT-**] 1: any of
numerous naturally occurring extremely complex combinations of
amino acids that contain the elements carbon, hydrogen, nitrogen,
oxygen, usu. sulfur, occas. phosphorus, iron, or other elements, are
essential constituents of all living cells, and are synthesized from
raw materials by plants but assimilated as separate amino acids by
animals 2: the total nitrogenous material in plant or animal
substances

ə abut; ɒ kitten; ɔr flourish; a back; ā bake; ä cot, cart; ʌ out; ch chin; e less; ē easy; g gift; i trip; I life
j joke; ŋ sing; ō flow; ô flaw; ô coin; th thin; th this; t loot; y foot; y yet; yū few; yū furious; z vision